

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/822,397 03/20/97 SCHWAB

B VID-00203/29

WM02/1003

EXAMINER

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ART UNIT

PAPER NUMBER

2611

DATE MAILED:

10/03/01

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

GM

Office Action Summary

Application No.

08/822,397

Applicant(s)

SCHWAB ET AL.

Examiner

Brown M. Reuben

Art Unit

2611

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***Period for Reply****A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
2a) This action is **FINAL**. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-40 is/are pending in the application.
4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 18-40 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17, drawn to integrating a plurality of TV signal sources, classified in class 725, subclass 59.
 - II. Claims 18-40, drawn to automatic selection of a TV program, based on a user's viewing preference, classified in class 725, subclass 35.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as the transmission of a plurality of programs and a user defining of channels. See MPEP § 806.05(d).
3. During a telephone conversation with John Posa on September 22, 2001 a provisional election was made without traverse to prosecute the invention of Group II, claims 18-40. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 18-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Freeman, (U.S. Pat # 5,724,091).

Considering claim 18, the claimed method of automatically changing a TV channel at a viewer location, comprising the step of entering at a viewer location, information regarding a viewer preference is met by the disclosure of Freeman, which discusses a user answering questions and/or personal profiles being stored at the user's set top box, Abstract, lines 16-20; col. 2, lines 61-67; col. 3, lines 45-50. Freeman meets the claimed step of transmitting from a broadcaster to a viewer location, a TV program including a pointer that automatically switches a TV program that the viewer is watching to another program based upon information entered by

the viewer, col. 11, lines 12-25. Freeman is directed to a system, which chooses between a plurality of TV channels, as function of a user's response to queries or general personal profile data, col. 11, lines 12-25; col. 14, lines 35-50 & col. 15, lines 5-15.

Considering claims 19-20, 30-31 & 37-38, Freeman is directed to CATV programs transmitted in digital format, col. 2, lines 28-32; col. 4, lines 35-50 & col. 15, lines 34-45.

Considering claims 21 & 28, Freeman discloses a handheld remote control, col. 2, lines 51-64.

Considering claims 22 & 29, Freeman uses an on-screen programming technique, col. 7, lines 25-31; col. 8, lines 1-10.

Considering claim 23, in Freeman the questions that a subscriber answers are transmitted from a CATV headend, which necessarily comprises a computer.

Considering claims 24-25, 32-33 & 39-40, in Freeman the pointer information may be transmitted with the TV program, col. 15, lines 5-15, as a data channel. Moreover, Freeman discloses a two-way system, which means that the headend transmits switching codes as a function of received subscriber responses, col. 3, lines 28-55.

Considering claim 26, Freeman provides a channel selector at a viewing location; see col. 12, lines 31-40. The claimed step of transmitting from a broadcaster to a viewing location a TV program on a primary TV channel, and additional information for directing the channel selector to automatically switch to one or more secondary TV channels reads on col. 15, lines 5-15.

Considering claim 34, Freeman meets the claimed TV viewing system comprising a source of TV programs including a channel change command, see Abstract. The claimed elements of a TV equipment for receiving a TV program, detecting a channel change command, and automatically selecting a different station in response to a viewer's channel-change command is met by the operation of Freeman, col. 15, lines 5-20 & col. 14, lines 1-25.

Considering claim 36, see Freeman, col. 2, lines 51-64; col. 7, lines 25-31; col. 8, lines 1-10.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Freeman, Vancelette Teach interactively switching between TV channels as a function of a user's response to queries.

B) Saxe Teaches providing various commercials to subscribers, based upon demographics.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 872-9314 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brown M. Reuben whose telephone number is (703) 305-2399. The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9314 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown


ANDREW FAILE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600